

Application No. 09/607,839  
Amendment "A" dated January 6, 2004  
Reply to Office Action mailed October 6, 2003

### REMARKS

The First Office Action, dated October 6, 2003, considered claims 1-33. Claims 1 and 4-8 were rejected under 35 U.S.C. § 102(e) as being anticipated by Cottrille (U.S. Patent No. 6,581,096), claims 9-15 and 27-33 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hinrichs (U.S. Patent No. 6,026,431), claims 16-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kikinis (U.S. Patent Application Publication No. US 2002/0049833 A1), claims 2-3 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Cottrille in view of Kikinis.<sup>1</sup>

By this paper certain passages of the specification have been amended, as reflected above, to provide missing patent application serial numbers, as requested by the Examiner, and to correct minor grammatical errors. Claims 1, 9, and 27 have also been amended and claims 16-26 have been cancelled, such that claims 1-33 remain pending.<sup>2</sup> Of these pending claims, the only independent claims at issue are claims 1, 9 and 27.

Claim 1 is directed to a method of using a decision engine to create a document for use by a client and that is customized according to attributes associated with the client. In particular, the method comprises various acts, including a server processing code associated with a script that requests a decision engine to select content for a client document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made; receiving from the decision engine an identification of the content that has been selected by the decision engine; creating the document and incorporating into the document the content that has been selected by the decision engine; and transmitting the document to the client.

Of the cited references, only Cottrille is used to reject claim 1. Accordingly, with regard to independent claim 1, and the corresponding dependent claims 2-8, Applicants will only address the teachings of Cottrille.

<sup>1</sup> Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited reference. Additionally, Kikinis was used to reject claims 16-26, which are cancelled by this amendment. Accordingly, the rejections made under Kikinis are now moot and are not being addressed at this time.

<sup>2</sup> Support for the claim amendments are found in the specification in at least the following places: P. 6, ll. 1-7; P. 15, ll. 14-15.

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Initially, it should be pointed out that the present application and Cottrille were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, either Microsoft Corporation or WebTV Networks, Inc., which is a wholly owned subsidiary of Microsoft Corporation. Accordingly, under the provisions of 35 U.S.C. § 103(c)<sup>3</sup>, Cottrille is disqualified as prior art under 35 U.S.C. § 103(a), thus removing the primary reference of record asserted in the 35 U.S.C. § 103(a) obviousness rejections to dependent claims 2 and 3.

Accordingly, the rejections made under 35 U.S.C. § 103(a) to dependent claims 2 and 3 should be withdrawn. Likewise, Cottrille should not be used in any future obviousness rejection under 35 U.S.C. § 103(a) for any of the claims presented in this application.

With regard to independent claim 1, Applicants respectfully submit that Cottrille fails to anticipate the recited method, particularly as it is now amended. In particular, the passages in Cottrille that were referred to by the Examiner merely teach that a computing system can dynamically create an HTML page containing requested content when a request from a client is received. (Col. 5, ln. 66-Col. 6, ln. 2). "Upon receiving a request from a community member for the home page, the community server 303 assembles the content for the home page and returns a dynamically created web page for display on the community member's browser." Col. 6, ll. 15-19.

This disclosure, however, fails to meet the burden for establishing a *prima facie* case of anticipation under 35 U.S.C. § 102(e), in which each and every element set forth in the claim must be found, either expressly or inherently. In particular, with regard to the first recited element, the Examiner has failed to show how Cottrille teaches of a server requesting a decision engine to select content for a document based on at least one attribute of the client. In fact, no mention is made at all regarding any Cottrille component considered to be analogous to the claimed decision engine.

Furthermore, in view of the amendment made to claim 1, Cottrille also fails to teach that a server requests the decision engine to select content for a document based on at least one attribute of the client, and without specifying either the at least one attribute of the client or how the selection of content is to be made. Cottrille also fails to teach, either explicitly or inherently,

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<sup>3</sup> It is noted that the present application was filed after November 29, 2000, such that it falls within the provisions of the AIPA.

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that the server receives an identification of content that has been selected by the decision engine which is subsequently incorporated into the document, as recited in the claims.

Accordingly, although Cottrille does teach that a document for a client can be dynamically created by a server, Cottrille fails to teach any method for creating a document in which content is selected by a decision engine.

These recited limitations are beneficial, as described in Applicants specification, because they create an environment in which "the scripts and the server application do not need to identify the value of attributes of the client" and wherein the "script developers or site administrators do not need to concern themselves with the decision process when writing scripts, which allows the script writing process to be streamlined and greatly reduces the logical complexity of the scripts...", as recited in Applicants Specification.<sup>4</sup>

For at least the foregoing reasons, Applicants respectfully submit that Independent claim 1 is not anticipated by Cottrille. Furthermore, inasmuch as Cottrille cannot be used as prior art for a 35 U.S.C. §103(a) obviousness rejection, as stated above, Applicants submit that claim 1 and the corresponding dependent claims are now in condition for allowance.

The next independent claim at issue, claim 9, is directed to a method of creating a document for use by a client, that is customized according to specified attributes associated with the client, and that comprises assembling a script that includes instructions for creating the document, wherein upon processing a first statement encoded in a script, the server issues a request for the decision engine to select a second portion of the script based on at least one of the specified attributes without the script identifying said at least one specified attribute. The server then receives the requested second portion of the script from the decision engine and concatenates the first portion of the script and the second portion of the script. The server then executes the first portion of the script and the second portion of the script so as to create the document.

Claim 27, which parallels claim 9, is directed to a computer program product for implementing the method recited in claim 9. Both of these independent claims have been rejected under 35 U.S.C. 102(e) as being anticipated by Hinrichs. Applicants respectfully

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<sup>4</sup> Page 6, ll. 7-14.

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submit, however, that Hinrichs neither anticipates nor obviates the method recited in claim 9 or the corresponding computer program product recited in claim 27.

Hinrichs is generally directed to a system for providing a user with parameter-specific information. In Hinrichs, a server receives a parameter-specific information request from a client that includes at least one parameter corresponding to requested parameter-specific information.<sup>5</sup> The client request also includes a command to invoke a file processing program to process a first information file.<sup>6</sup> Thereafter, the file processing program is invoked and processes an information file for display by the client.<sup>7</sup>

It should be appreciated, however, that this is different than the recited method of the present invention, in claims 9 and 27. In particular, the file processing program recited in Hinrichs is invoked in response to a specific command received from the client. This is contrasted with the method recited in claims 9 and 27, in which the decision engine that is invoked by the server and only upon processing a first portion of an encoded script.

Furthermore, the client request in Hinrichs, which explicitly dictates the parameter identification for which the information file is requested, is processed by the server and passed onto the file processing program. This is distinguished from the pending claims 9 and 27, in which the request for the decision engine to select a second portion of the script is made on specified attributes of the client that are identified by the decision engine without the request or script identifying the attributes.

Accordingly, for at least these reasons, Applicants respectfully submit that the amended independent claims 9 and 27 are neither anticipated by nor made obvious by Hinrichs.

Furthermore, although the remarks have primarily been directed to the independent claims, it will be appreciated that the pending dependent claims are distinguished from the art of record for at least the same reasons as articulated above, regarding the respective independent claims. Accordingly, at this time, Applicants respectfully submit that all of the pending claims 1-15 and 27-33 are now in condition for prompt allowance.

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<sup>5</sup> Col. 1, ln. 66-Col. 2, ln. 3.

<sup>6</sup> Col. 7, ll. 11-12, 65-Col. 8, ln. 2


<sup>7</sup> Col. 2, ll. 3-4.

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In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 6<sup>th</sup> day of January, 2003.

Respectfully submitted,



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